

REMARKS

Claim Amendments

Claims 1, 8, 18 and 19 are amended. Upon entry of the amendment, claims 1-12, 14-16 and 18-20 are presented for reconsideration by the Examiner.

Claim Objections

Claims 1, 8, 18 and 19 are amended to relate the various steps and apparatus to each other in a manner believed to overcome the Examiner's objections.

Claim Rejections - 35 USC § 101

Each of independent claims 1, 8, 18 and 19 are amended to include steps that employ the recited mass measurement to produce a tangible result. For example, claim 1 is amended to recite "and sorting the portioned units according to their mass M." Claims 8, 18 and 19 are amended to recite "a device for removing individual units of active substances having a mass outside a predetermined range." Each of independent claims 1, 8, 18 and 19 now uses the mass measurement to produce a tangible result of sorted portioned units. These amendments are believed to overcome any claim rejections on the basis of 35 USC § 101.

Claim Rejections – 35 USC § 102

Claim 8 is rejected under 35 USC § 102 as being anticipated by US Patent No. 6,837,122 to Herrmann et al. (hereinafter Herrmann).

Claim 8 is directed to "An apparatus for determining the mass of portioned units of active substances, in particular capsules, tablets or dragees." Claim 8 recites "a device for guiding the units of active substances through the microwave resonator" and "measuring and evaluation electronics for determining the mass from the displacement A of the resonant frequency and the broadening B of the resonance curve caused by

the presence of each unit in the microwave field.” Claim 8 further recites “a device for removing individual units of active substances having a mass outside a predetermined range.”

The Examiner asserts that the limitations relating to portioned units are recited in the preamble and therefore afforded little patentable weight. Applicant points out that the portioned units recited in the preamble are repeated throughout the body of claims 1, 8, 18 and 19. Further, the portioned units are acted on by measuring steps or devices and sorted in sorting steps or devices. The portioned units limitation appears throughout each of claims 1, 8, 18 and 19 and must be afforded patentable weight.

In contrast, Herrmann teaches a device and method for detecting the mass and moisture content for spinning preparation machines. Specifically, Herrmann teaches a device for measuring mass and/or moisture of a continuous and uninterrupted material running through a spinning preparation machine. The corresponding material strands are very long. Herrmann is arranged to determine not the mass of a portioned unit, as in the case of claim 8, but the mass per unit length of a continuous and uninterrupted strand or web of material.

The Examiner’s assessment of Figure 3 of Herrmann is incorrect. Figure 3 of Herrmann shows only a portion of what are described as continuous strands or webs of material. Obviously, a continuous strand must be illustrated in a discontinuous manner. Please refer to Figures 1 and 2 and the description spanning column 3, line 66 through column 4, line 42. What is described is clearly the measurement of continuous strands or webs and not portioned units as recited in the claims.

Herrmann does not disclose, teach or suggest the apparatus recited in claim 8. Claim 8 is specific with regard to “determining the mass of portioned units of active substances” and recites “a device for guiding the units of active substances through the microwave resonator” and “a device for removing individual units of active substances having a mass outside a predetermined range.” Herrmann does not disclose, teach or

Appl. No.: 10/820,244
Amdt. dated October 30, 2006
Reply to Office Action of August 3, 2006

suggest such an arrangement. Claim 8 cannot be anticipated by Herrmann. Claim 8 is therefore patentable over the teachings of Herrmann.

Claim Rejections 35 USC § 103

Claim 9 is rejected under 35 USC § 103 as being unpatentable over Herrmann in view of U.S. Patent No. 5,602,485 to Mayer et al. (Mayer). Mayer discloses an apparatus for screening capsules using velocity measurements. In Mayer the weight of individual capsules is determined by passing a stream of capsules past a capacitance sensor which measures the change in capacitance of the sensor as representative of the capsule weight and passing the stream of capsules past a velocity sensor which measures the velocity of each capsule as representative of the capsule weight. Applicant describes the approach taken in Mayer as a prior art attempt to overcome the disadvantages in the field of monitoring the masses of units of active substances. See paragraph 5 of Publication No. US 2004/0225454 A1.

Claim 9 depends from claim 8 and, as discussed above, Herrmann does not disclose, teach or suggest the recitations of claim 8.

Herrmann and Mayer are very different and distinct technologies constructed for very different purposes. The materials tested in Herrmann are continuous fiber strands and have no need for conveyance by air stream. One of ordinary skill in the art in possession of Herrmann would have no incentive or motivation to seek out the teachings of Mayer. The only connection between these references is an impermissible hindsight reference to Applicant's specification and claims. There is no suggestion in the references themselves that would lead one of skill in the art to modify Herrmann with the teachings of Mayer.

The Examiner's proposed motivation for combining the teachings of Herrmann with those of Mayer "is for the purpose of improving the processing rate of the substance" as disclosed in Mayer, column 1, lines 32-35. As an initial matter, Herrmann teaches that the material being measured is a continuous material being moved

Appl. No.: 10/820,244
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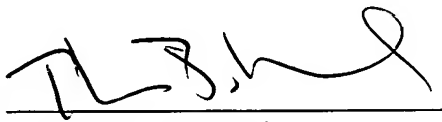
through a spinning preparation machine. This is very different and distinct from the individual units being processed in Mayer. One of skill in the art would understand that applying an air stream to the continuous material passing through the device of Herrmann would not improve the processing rate of the substance as suggested by the Examiner. The Examiner's proposed motivation finds no support in the disclosures of Herrmann or Mayer, or in the knowledge of one of skill in the art.

The Examiner has failed to present a *prima facie* case of obviousness with respect to claim 9 because the proposed combination finds no motivation in the references or in the knowledge of one of skill in the art and, even if carried out, the Examiner's proposed combination fails to teach all of the limitations of claim 9.

For all the foregoing reasons, Applicant respectfully requests allowance of claims 1-12, 14-16 and 18-20.

Respectfully submitted,

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